

REMARKS

Claims 1, 5-11, 15 and 18 are pending in the application.

Claims 1, 6-8, 10 and 18 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 6,231,458 to Cameron, et al. The claims have now been amended to include a limitation that the face insert is retained to the club head body solely by the adhesive layer. The Examiner takes the position that silicone is inherently an adhesive material. That may be the case, however, silicone is a poor adhesive for use in golf clubs. Accordingly, all of the embodiments of Cameron rely on either threaded fasteners (e.g., FIG. 5, col. 4, lns. 28-50) or a press fit between the insert and club head (e.g., FIGs. 15-16, col. 5, lns. 20-30) to retain the face insert within the cavity. Therefore, Cameron does not anticipate claims 1, 6-8, 10 or 18 as amended.

Regarding claim 7, the Examiner takes the position that Cameron, et al. discloses a cavity insert composed of a third material disposed in the second cavity and relies on FIG. 8 of Cameron in support. However, since claim 7 as amended depends from claim 1 which already recites an adhesive layer that extends into the cavity apertures, claim 7 must be interpreted such that the third material is a material other than the adhesive that fills the aperture. FIG. 8 of Cameron however discloses the same material filling both the apertures and the insert back cavity. Therefore, Cameron cannot anticipate a claim that includes a third material filling the cavity in addition to the adhesive that forms a layer between the face insert and the cavity bottom.

Claims 1 and 11 stand rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,729,972 to Boord. In the middle of the paragraph of the Office Action explaining the §102 rejection based on Boord, however, the Examiner inexplicably refers to FIGs. 13 and 15 as well as col. 3 and col. 5 of Cameron, et al. This is not a proper rejection as anticipation requires a single reference to disclose each and every element of the claim. Accordingly, this rejection should be withdrawn.

Regarding claim 11, the Examiner takes the position that the method of assembly is impliedly anticipated by Boord referring to col. 7 of Boord for support. Applicants observe that Boord has no col. 7. Accordingly, this rejection is unintelligible and should be withdrawn.

Claim 11 is also rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,921,871 to Fisher. Applicant does not dispute the Examiner's statement that silicone is inherently an adhesive, however, applicants' attorney has scoured U.S. Patent No. 5,921,871 and has found no reference to an adhesive, silicone or otherwise, disposed between the back surface of the face insert and the bottom wall of the cavity. FIGs. 2 and 7 of U.S. Patent No. 5,921,871 to Fisher admittedly include reference numerals 48 and 49 pointing to the lower surface of the cavity. Applicants' attorney, however, could find nothing in the patent that indicates what items 48 or 49 are, and the Examiner has never cited to a column or line in U.S. Patent No. 5,921,871 that indicates that reference 48 or 49 is an adhesive. Instead, applicant observes that the adhesives are identified as reference 47A and 47B which are not disposed between the back surface of the face insert and the bottom surface of the cavity.

Being unable to comprehend the Examiner's reliance on U.S. Patent No. 5,921,871 to Fisher, applicants' attorney found a different patent issued to Dale Perry Fisher, namely U.S. Patent No. 5,674,132, which pursuant to 37 C.F.R. §1.56 applicants are disclosing to the Examiner. In U.S. Patent No. 5,674,132 reference 48 is described as grooves for receiving an adhesive (Reference 49 is described as a dimple for locating the face insert). Although U.S. Patent 5,674,132 has a face insert that is retained solely by adhesive, it does not have apertures in the cavity. Similarly, even if the mere existence of a reference numeral carried over from a previous patent but not mentioned in U.S. Patent No. 5,921,871 could be interpreted to imply there is an adhesive between the face insert and the bottom of the cavity (which would defeat the removability feature of the patent), the '871 patent does not retain the insert solely by adhesive. Accordingly, neither the Fisher patent relied on by the Examiner nor the Fisher patent found by applicants anticipate claim 11.

Applicants are mystified by the Examiner's reliance of FIG. 15 of U.S. Patent No. 5,921,871 to Fisher since the patent has neither a FIG. 15 nor a column 7.

Claim 5 stands rejected under 35 U.S.C. §103(a) as being obvious considering U.S. Patent No. 6,231,458 to Cameron. For the reasons discussed above, since Cameron does not disclose or suggest a face insert that is retained solely by adhesive extruded through apertures in the bottom of the face insert cavity, Cameron does not provide a basis for the obviousness rejection.

Claim 15 stands rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,921,871 to Fisher in view of U.S. Patent No. 5,924,939 to Grace, et al. In addition to the

reasons discussed above why the Examiner's reliance on Fisher is misplaced, claim 15 as amended includes the limitation that the second cavity is defined by a perimeter surface and a planar bottom surface. Grace discloses a golf club head in which the first face insert has recesses into which projections forming "indicia" (e.g., logos or letters forming the manufacture's name) formed on the second insert extend. Since Grace discloses and teaches multiple letter or logo shaped recesses in the first face insert, Grace does not disclose a first face insert in which the cavity is defined by a planar bottom surface. Accordingly, for this additional reason claim 15 is not obvious considering Fisher in view of Grace.

Conclusion

No new matter is introduced by the amendments herein. Based on the foregoing, applicants believe that all claims under consideration are in a condition for allowance and reconsideration of this application is respectfully requested.

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Respectfully submitted,

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